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Attorneys for Plaintiff

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

OAKLEY, INC., a Washington
Corporation,

Plaintiff,

vs.

WEYCO GROUP, INC., a Wisconsin
Corporation, dba NUNN BUSH,

Defendant

Case No. **08 CV 0480 L RBB**

) COMPLAINT FOR TRADEMARK
) INFRINGEMENT, UNFAIR
) COMPETITION, AND FALSE
) DESIGNATION OF ORIGIN
) DEMAND FOR JURY TRIAL
)
)
)

Plaintiff OAKLEY, INC. (hereinafter referred to as "Oakley") hereby complains of Defendant WEYCO GROUP INC., dba NUNN BUSH (hereinafter referred to as "Weyco"), and alleges as follows:

JURISDICTION AND VENUE

1. Jurisdiction over this action is founded upon 15 U.S.C. § 1121, and 28 U.S.C. § 1331. Venue is proper under 28 U.S.C. §§ 1391(b) and (c), this claim having arisen and Defendant doing business in this district.

....

THE PARTIES

2. Plaintiff Oakley is a corporation organized and existing under the laws of the State of Washington, having its principal place of business at One Icon, Foothill Ranch, California 92610, doing business within this judicial district.

3. Oakley is informed and believes, and thereupon alleges that Defendant Weyco is a Wisconsin corporation with its principal place of business located at 333 W Estabrook Blvd., Glendale, Wisconsin 53212. Oakley is informed and believes, Defendant is doing business as Nunn Bush on www.nunnbush.com. Oakley alleges that Defendant Weyco is doing business within this judicial district through its distribution of product to third parties within and throughout this judicial district and through its website www.nunnbush.com, and others.

FACTUAL BACKGROUND

4. As early as 1976, Oakley has been and continues to be actively engaged in the manufacture and sale of high quality sport eyewear products, footwear, and apparel. Oakley is currently manufacturing and selling several lines of footwear and accessories under the "Oakley" name, which has come to be known as a source indicator of Oakley products. The "Oakley" trademark has been used continuously in association with its footwear products since 1997.

5. Oakley is the owner of U.S. Registered Trademark No. 2,293,046, duly registered on November 16, 1999, claiming the trademark "OAKLEY" for use on goods in Classes 25. A true and correct copy of this trademark registration is attached hereto and incorporated by reference as Exhibit 1.

6. The trademark registration referred to above is in full force and effect. The trademark and the good will of the business of Plaintiff Oakley in connection with which the trademark has been used have never been abandoned. Oakley continues to preserve and maintain its rights with respect to said trademark registration.

1 7. The trademark above is inherently distinctive in appearance and has become,
2 through public acceptance, a distinctive designation of the source of origin of
3 goods offered by Oakley.

4 8. Plaintiff is informed and believes and based thereon alleges that Defendant
5 Weyco and its agents, employees, and servants have advertised and sold products
6 bearing the trademark referred to above, which advertisements and products sold
7 are confusingly similar to that of the Oakley's trademark, and are, therefore, an
8 infringement of Oakley's above described trademark.

9 9. Defendant has received written notice of Oakley's proprietary rights in its
10 trademark by way of actual written notice from Oakley's attorneys. Further,
11 Defendant has received constructive notice of Oakley's trademarks as Oakley
12 caused the trademarks to be placed plainly on the advertisements and/or packaging.
13 Despite said actual and constructive knowledge, Defendant has continued to
14 infringe Oakley's trademark rights. On information and belief, such infringement
15 by Defendant has been willful and wanton.

16 10. Since 1997, Oakley has expended money in the promotion of its footwear
17 product lines utilizing the "Oakley" trademark. As a result of these promotional
18 efforts, Oakley products have become and are now known to be connected to the
19 mark and are recognized in this District and elsewhere as emanating from and
20 authorized by Oakley.

21 11. Oakley's products and their connection with the "Oakley" trademark have
22 become, through public acceptance, a distinctive designation of the source of
23 origin of goods offered by Oakley and an asset of incalculable value as a symbol of
24 Oakley and its quality goods and good will.

25 12. Oakley is informed and believes and thereupon alleges that the Defendant's
26 Nunn Bush line of footwear products bearing the name "Oakley", are designed,
27 manufactured, packaged, advertised, displayed and/or sold expressly to deceive
28 customers desirous of purchasing products authorized by Oakley or to profit from

1 the demand created by Oakley for the inherently distinctive features of the Oakley
2 products.

3 13. Oakley is further informed and believes and thereupon alleges that the
4 presence of Defendant's products in the marketplace using a mark that is the same
5 or substantially similar to Oakley's trademark damages the value of Oakley's
6 exclusive rights. The presence of the products in the marketplace using a mark that
7 is the same or substantially similar to Oakley's trademark is likely to diminish the
8 apparent exclusivity of the genuine Oakley products thereby dissuading potential
9 customers who otherwise would have sought Oakley products. Upon information
10 and belief, Oakley alleges that such deception has misled and continues to mislead
11 and confuse many of the purchasers to buy the products sold by Defendant and/or
12 has misled non-purchasers to believe the products emanate from or are authorized
13 by Oakley.

14 14. Oakley is informed and believes and thereupon alleges that the sale of
15 Defendant's products using a mark the same or substantially similar to Oakley's
16 trademark has resulted in lost sales, has reduced the business and profit of Oakley,
17 and has greatly injured the general reputation of Oakley, all to Oakley's damage in
18 an amount not yet fully determined.

19 15. The exact amount of profits realized by Defendant as a result of its
20 infringing activities, are presently unknown to Oakley, as are the exact amount of
21 damages suffered by Oakley as a result of said activities. These profits and
22 damages cannot be accurately ascertained without an accounting. Further,
23 Defendant's actions are irreparably injuring Oakley and will continue unless and
24 until enjoined by this court.

25 **FIRST CLAIM FOR RELIEF**

26 16. The allegations of paragraphs 1 through 15 are repled and realleged as
27 though fully set forth herein.
28

1 17. This is a claim for trademark infringement, and arises under 15 U.S.C. §
2 1114 against Defendant Weyco.

3 18. Jurisdiction is founded upon 15 U.S.C. § 1121.

4 19. Oakley is the owner of U.S. Registered Trademark No. 2,293,046, which
5 confer on Oakley the exclusive right to use this trademark in commerce. True and
6 correct copies of U.S. registered Trademark No. 2,293,046 is attached hereto as
7 Exhibit 1.

8 20. The mark has been in use in commerce in connection with the sale of
9 Oakley footwear products continuously since at least as early as their respective
10 dates of issue. The marks appear clearly on product, packaging, advertisements,
11 product brochures, and/or the website www.oakley.com.

12 21. Defendant, through their agents, employees and servants, have
13 manufactured, advertised, and sold products using a substantially similar mark to
14 Oakley's registered marks without authority from Oakley for doing so.

15 22. Oakley is informed and believes, and thereupon alleges, that Defendant's
16 use of the name "Oakley" is identical to Oakley's registered trademark "Oakley".
17 Accordingly, Defendant's product should be considered counterfeit. Defendant's
18 use is within the same class of goods as Oakley's trademark rights, class 25.

19 23. Oakley is informed and believes, and thereupon alleges, that Defendant's
20 use of "Oakley" in connection with goods in commerce constitutes trademark
21 infringement, false designation or origin, a false description or representation of
22 goods and wrongfully and falsely represents to the consuming public that the
23 Defendant's advertising and products bearing the Oakley trademark originated
24 from or somehow are authorized by Oakley.

25 24. Oakley is informed and believes, and thereupon alleges, that Defendant's
26 unauthorized use of Oakley's registered trademark has caused confusion in the
27 marketplace as to the source of origin of Defendant's products and has caused
28 damage to Oakley within this jurisdictional district.

1 25. Oakley is informed and believes, and thereupon alleges, that Defendant's
2 willfully infringed upon Oakley's exclusive rights under its trademark with the
3 intent to trade upon the good will of Oakley and to injure Oakley.

4 26. Oakley is informed and believes, and thereupon alleges, that Defendant has
5 derived, received, and will continue to derive and receive from the aforesaid acts of
6 infringement, gains, profits, and advantages in an amount not yet ascertainable, but
7 will be determined at the time of trial.

8 27. Oakley is informed and believes, and thereupon alleges, that Defendant will
9 continue to infringe Oakley's registered trademark to the great and irreparable
10 injury of Oakley, for which Oakley has no adequate remedy at law unless
11 Defendants are enjoined by this court.

12 28. Oakley has been damaged in this judicial district as a result of the
13 Defendant's infringement of its trademark.

14 **SECOND CLAIM FOR RELIEF**

15 29. The allegations of paragraphs 1 through 28 are repled and realleged as
16 though fully set forth herein.

17 30. This is an action for unfair competition, false designation of origin of goods,
18 and false description or representation of goods against Defendant, pursuant to 15
19 U.S.C. § 1125(a).

20 31. Jurisdiction is founded upon 15 U.S.C. § 1121.

21 32. Oakley is informed and believes and thereupon alleges that Defendant's use
22 of "Oakley" constitutes a false designation of origin, a false description or
23 representation of goods, and wrongfully and falsely represents to the consuming
24 public that the Weyco products originated from or somehow are authorized by
25 Oakley. These acts amount to utilizing a false designation of origin and a false
26 description or representation in interstate commerce to compete unfairly with
27 Oakley.
28

1 33. Oakley is informed and believes and thereupon alleges that the actions of
2 Defendant was done willfully, knowingly and maliciously with the intent to trade
3 upon the good will of Oakley and to injure Oakley.

4 34. The Defendant's acts are in violation of 15 U.S.C. § 1125(b), and will
5 continue to the great and irreparable injury of Oakley unless enjoined by this
6 Court.

7 WHEREFORE, Plaintiff Oakley, Inc. prays as follows:

8 1. That Defendant be adjudicated to have infringed Oakley's Registered
9 Trademark No. 2,293,046, and that the trademark is valid and enforceable
10 and is owned by Oakley;

11 2. That Defendant, and his agents, servants, employees, and attorneys
12 and all persons in active concert and participation with them, be enjoined
13 and restrained, during the pendency of this action and permanently thereafter
14 from:

15 A. Using the Oakley's Registered Trademark No. 2,293,046 or
16 any mark similar thereto in connection with the sale of any goods;

17 B. Using "Oakley" mark in connection with the sale of any goods;

18 C. Committing any acts which may cause purchasers to believe
19 that the Defendant or the products Defendant is selling are sponsored
20 or authorized by, or are in any way associated with Plaintiff;

21 D. Selling, passing off, or inducing or enabling others to sell or
22 pass off any products as products produced by Plaintiff, which
23 products are not Plaintiff's or are not produced under the control and
24 supervision and approved by Plaintiff; and

25 E. Infringing Plaintiff's trademark rights;

26 3. That Defendant, its agents, servants, employees and attorneys and all
27 persons in active concert or participation with them, be enjoined and
28 restrained, during the pendency of this action, and permanently thereafter

1 from advertising or selling products in any manner that does or tends to
2 dilute the distinctive value of Oakley's "Oakley" trademark;

3 4. That Defendant be directed to file with this court and serve upon
4 Oakley within 30 days after the service of the injunction, a report in writing
5 under oath, setting forth in detail the manner and form in which Defendant
6 has complied with the injunction;

7 5. That Defendant be required to account to Oakley for any and all
8 profits derived by it, and all damages sustained by Oakley by reason of
9 Defendant's trademark infringement, unfair competition and false
10 designation of origin, together with interest and costs;

11 6. For all of Defendant's profits derived from their infringement of
12 Plaintiff's trademark rights pursuant to 15 U.S.C. § 1117;


13 7. For treble damages under 15 U.S.C. § 1117;

14 8. That an award of reasonable costs, expenses, and attorney's fees be
15 awarded against Defendant pursuant to 15 U.S.C. § 1116(a); and

16 9. That Oakley have such other and further relief as the circumstances of
17 this case may require and as this court may deem just and proper.

18 DATED: March 14 2008

WEEKS, KAUFMAN, NELSON & JOHNSON

19 

20 Chandler G. Weeks

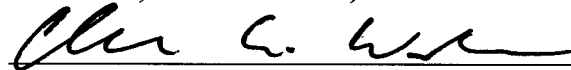
21 Attorney for Plaintiff, Oakley, Inc.

22 JURY DEMAND

23
24 Plaintiff Oakley, Inc. hereby requests a trial by jury in this matter.

25 DATED: March 14 2008

WEEKS, KAUFMAN, NELSON & JOHNSON

26 

27 Chandler G. Weeks

28 Attorney for Plaintiff, Oakley, Inc.

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,293,046

United States Patent and Trademark Office

Registered Nov. 16, 1999

**TRADEMARK
PRINCIPAL REGISTER**

OAKLEY

OAKLEY, INC. (WASHINGTON CORPORATION)
10 HOLLAND
IRVINE, CA 92718

FOR: CLOTHING, HEADWEAR AND FOOTWEAR AND FOOTWEAR, NAMELY, SPORT SHIRTS, JERSEYS, SHIRTS, JACKETS, VESTS, SWEATSHIRTS, PULLOVERS, COATS, SKI PANTS, HEADWEAR, CAPS, SHOES, ATHLETIC FOOTWEAR, ALL PURPOSE SPORTS

FOOTWEAR AND SOCKS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 10-0-1997; IN COMMERCE 10-0-1997.

OWNER OF U.S. REG. NOS. 1,356,297, 1,522,692, AND 1,980,039.
SEC. 2(F).

SN 75-154,056, FILED 8-22-1996.

DOMINICK J. SALEMI, EXAMINING ATTORNEY

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

OAKLEY, INC., a Washington corporation

(b) County of Residence of First Listed Plaintiff Orange County, CA
(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorney's (Firm Name, Address, and Telephone Number)

Weeks, Kaufman, Nelson & Johnson, 462 Stevens Avenue, Suite 310,
Solana Beach, CA 92075 (858) 794-2140

DEFENDANTS

WEYCO GROUP, INC., a Wisconsin corporation, dba NUNN BUSH

County of Residence of First Listed Defendant Milwaukee County, WI

(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE
LAND INVOLVED.

Attorneys (If Known)

08 CV 0480 L RBB

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
- ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant
- ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury	<input type="checkbox"/> 362 Personal Injury - Med. Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input type="checkbox"/> 840 Trademark
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 440 Other Civil Rights	PRISONER PETITIONS <input type="checkbox"/> 510 Motions to Vacate Sentence Habeas Corpus: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition	LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act	<input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) SOCIAL SECURITY <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609
				<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes

V. ORIGIN

(Place an "X" in One Box Only)

- ☒ 1 Original Proceeding
- ☐ 2 Removed from State Court
- ☐ 3 Remanded from Appellate Court
- ☐ 4 Reinstated or Reopened
- ☐ 5 Transferred from another district (specify)
- ☐ 6 Multidistrict Litigation
- ☐ 7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):
15 U.S.C. Section 1114

Brief description of cause:

This is a case of trademark infringement

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No

VIII. RELATED CASE(S) IF ANY

(See instructions):

JUDGE

DOCKET NUMBER

DATE

SIGNATURE OF ATTORNEY OF RECORD

03/14/2008

FOR OFFICE USE ONLY

RECEIPT #

AMOUNT

APPLYING IFP

JUDGE

MAG. JUDGE

148788 \$350 3/14/08

**UNITED STATES
DISTRICT COURT**
SOUTHERN DISTRICT OF CALIFORNIA
SAN DIEGO DIVISION

148788 — SH

**March 14, 2008
16:23:17**

Civ Fil Non-Pris

USAO #.: 08CV0480

Judge..: M. JAMES LORENZ

Amount.: \$350.00 CK

Check#.: BC1080

Total-> \$350.00

FROM: OAKLEY INC. V. WEYCO GROUP INC